

an alternative network address from the identified service node related to a wireless service.

19. (Amended) The method of claim 17 wherein said step of exchanging second information comprises the sub-step of transmitting an address addressable by an alternative network address to the identified service node related to a wireless service.

Remarks

Claims 1-24 are pending in the application. Claims 17, 19-21 and 24 have been allowed. Claims 1-16, 18, 22 and 23 have been rejected. Favorable reconsideration is respectfully requested.

The claims have been amended as set forth above to place them in a form indicated to be preferred by the Examiner. The amendments in no way narrow the scope of the claims.

Claims 1-16, 18 and 22-23 were rejected under 35 USC 112, second paragraph. The Applicant respectfully requests withdrawal of this rejection in view of amendments, as set forth above, with respect to the recitation "alternative network addresses".

Further, with regard to the Examiner's more specific remarks concerning claim 12, the Applicant respectfully submits that claim 12 as amended is fully compliant with § 112. It is observed that 35 USC 112 states that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The MPEP provides further guidance concerning the clarity and precision required of claims. As described in § 2173.02, the Examiner "should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness" (emphasis in original). Examiners "should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." § 2173.02. Further, according to § 2173.04, "[i]f the scope of the

subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C., second paragraph."

Notwithstanding, in the more specific remarks rejecting claim 12, the Examiner does not allege any lack of clarity as to scope, or otherwise. Rather, the Examiner appears to be citing a requirement that the body of a claim "provide necessary steps" "as to how [an element of the preamble] is achieved." However, in so doing, the Examiner imports requirements into § 112 which have no basis in the law. As shown above, neither the statute nor the MPEP sets forth any requirement along the lines alleged by the Examiner. If the Examiner knows of other authority that does support his position, the Examiner is respectfully requested to cite it.

Claim 1 was further rejected under 35 USC 102(b) as being anticipated by Henry, Jr. et al. (Henry) (U.S. Patent No. 5,603,084).

To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). In view of this authority, the Applicant respectfully submits that the cited reference fails to support the asserted rejection.

The invention as recited in claim 1 relates to a method of transferring information between a subscriber and a wireless service. The method comprises the steps of receiving a registration request for the subscriber at a service node, and determining, at the service node, an address addressable by an alternative network and associated with a wireless service. The method further comprises transferring information between the subscriber and the wireless service using the determined address.

Henry describes an arrangement that purports to "remotely program" a mobile radiotelephone. To this end, Henry describes a cellular system that provides a MIN (Mobile Identification Number) to the radiotelephone in response to receiving an IIN (initial identification number) from the radiotelephone when it is activated. The cellular system uses the MIN (a unique number assigned by the cellular system) to

"route calls to the phone and to keep track of account information relating to the radiotelephone" (col. 5, lines 45-47; see also col. 7, lines 20 *et seq.*).

Thus, Henry fails to anticipate claim 1 for at least the reason that Henry does not disclose using an address addressable by an alternative network, as required by claim 1. Rather, the exchange of the IIN and MIN in Henry take place via a single cellular system 18 (see Fig. 1). By contrast, according to the present invention as claimed, transfer of information is possible via an alternative network such as IP network 200 (see Fig. 2 of the present application).

In consideration of the above, the anticipation rejection of claim 1 is not sustainable. Accordingly, withdrawal of the rejection is respectfully requested.

In light of the foregoing discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees under 37 C.F.R. 1.16 or 1.17 related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Dated: 9/25/02

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VERSION OF AMENDMENTS MARKED UP TO SHOW CHANGES MADE

In the claims:

Please amend the claims as follows:

1. (Amended) A method of transferring information between a subscriber and a wireless service, comprising the steps of:

receiving a registration request for the subscriber at a service node;
determining, at the service node, an address addressable by an alternative network [address] and associated with a wireless service; and
transferring information between the subscriber and the wireless service using the determined [alternative network] address.

12. (Amended) A method of using an alternative network to provide wireless services comprising:

determining a list of wireless services to be offered to a subscriber;
identifying a corresponding list of addresses addressable by an alternative network [addresses] for each service;
communicating the wireless services list and the corresponding [alternative] addresses list between a service node and a Serving Control Point (SCP).

13. (Amended) The method of claim 12, wherein the step of communicating comprises:

sending the wireless services list and [alternative network] addresses list from the service node to the SCP.

14. (Amended) The method of claim 15, wherein the step of communicating comprises:

sending the wireless services list and [alternative network] addresses list from the SCP to the service node.

15. (Amended) The method of claim 12, wherein the list of wireless services and the corresponding list of [alternative network] addresses each comprise two lists, wherein the first wireless services list and its corresponding [alternative network] addresses list are stored in the service node and the second wireless services list and its corresponding [alternative network] addresses list are stored in the SCP; and the step of communicating comprises exchanging the two sets of lists between the service node and the SCP.

16. (Amended) The method of claim 13, further comprising the step of forwarding a single wireless service and an address addressable by the alternative network [address] from the SCP to a node associated with the wireless service.

18. (Amended) The method of claim 17 wherein said step of exchanging second information comprises the sub-step of receiving an address addressable by an alternative network address from the identified service node related to a wireless service.

19. (Amended) The method of claim 17 wherein said step of exchanging second information comprises the sub-step of transmitting an address addressable by an alternative network address to the identified service node related to a wireless service.